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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,023	02/03/2006	Sabine Giessler	284430US0PCT	9476
22850	7590	06/26/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
BRUNSMAN, DAVID M				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
06/26/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/567,023

Applicant(s)

GIESSLER ET AL.

Examiner

David M. Brunsmann

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 April 2008 has been entered.

Claims 4 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out the antecedent basis in the specification as originally filed for the term "a positive amount". In response to this office action the new matter added must be cancelled.

The following rejections are made anticipating the cancellation of new matter that is required above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 4, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites a range including 0% of a component recited in its parent claim 3. It is unclear if one of formula III or IV is required in nonzero amounts. Claim 8 recites amounts of solvent, in the component of formulation 2 of less than 100.

Examiner appreciates applicant's response to clarify the meaning of these claims. While applicant's response does appear to specifically indicate the meaning of the terms employed, a conflict yet exists in the instant claims in that claims 3 and 1 appear to positively recite the presence of an ingredient that may be added in an amount of 0% as described in claims 4 and 8, therefore being optional.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11, 13, 14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5997943 in view of US 4678835.

US 5997943 teaches a process for improving the weatherability of glass comprising cleaning a glass panel, optionally pretreating it with a hydrolysable silane, forming a mixture of silanes falling within the scope of formula (I) with a solvent system comprising ethanol and water and, an acid catalyst, and applying the mixture (at room temperature) by wiping (falls within the scope of "polishing"). The mixture contains 0.1-3% silane, 76-86% ethanol, 5-14% water and 10% acid catalyst. The text of the example does not clearly set forth the order in which the ingredients are combined. Column 2, lines 9-15 teach that the solvent system preferably contains a solubilizer (ethanol), a catalyst (acid) and a hydrolyser (water). Thus, the reference clearly discloses a component comprising water, solvent and acid catalyst to which the previous silane component is added.

The amendment to the instant claims explicitly sets out each component contained in its own sealed vessel. The US 5997943 does not teach the silane component and the solvent system held separately in sealed vessels. US 4678835 teaches that coating compositions comprising a silane component (a), including haloalkoxysilanes (column 13, line 48) and a different component capable of cocuring with the first component (b), wherein the second component may include alcohol, water and acid. US 4678835 teaches that the coating systems may be used as a one package or as a two package composition wherein "the second pack comprises the material functionally capable of cocuring" with "component (a)". See column 24, lines 49-65. Column 18, lines 23-25, teach that the silanes in component (a) can moisture cure by reaction of the hydrolyzable silane groups. In combination with the art

recognized tendency of hydrolyzable silanes to undergo hydrolysis due to exposure to atmospheric water, US 4678835 shows that it would have been obvious to one of ordinary skill in the art to formulate the composition of US 5997943 as a two package system. Starting with the teaching of US 5997943 of the addition of a silane of formulation I of the instant claims to a solvent component of formulation II of the instant claims, US 4678835 teaches that compositions including similar ingredients can be made into one pack or two pack systems. That hydrolyzable silanes are curable by moisture and that using a two pack system keeps the first part, including hydrolyzable silane, and the second part, including the material necessary to cure the first separate until the intended use. One of ordinary skill in the art would apply the teachings of 4678835 to formulate the composition of 5997943 as a two part system. In view of the clear teaching that a hydrolyzable silane is susceptible to moisture, one of ordinary skill in the art would be motivated to seal the packages of the two part system to prevent contamination with atmospheric water.

While claim 3 recites the addition of a compound of formula III or IV, claim 4, as previously written, depending therefrom clearly allows 0% addition rate by use of "less than 10% by weight". Claim 10, as previously written, similarly allows a 0% addition rate of wetting agent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5997943 in view of US 4678835, as applied above, in view of US 5264010.

The difference between the primary references and claim 12 is the use of a metal oxide slurry as part of the pretreatment step. US 5264010 teaches the use (See the Background of the Invention) metal oxide slurries to polish glass surfaces. It would have been obvious to one of ordinary skill in the art to employ a metal oxide slurry in the pretreatment of the substrates of 5997943 because 5264010 teaches they are useful to polish glass surfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, Th, F, Sa; 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David M Brunsman/
Primary Examiner, Art Unit 1793

DMB